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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,886	05/21/2002	Hsu-Chu Chien	CHEP0006USA	2361
27765	7590	04/02/2004	EXAMINER	
NAIPO (NORTH AMERICA INTERNATIONAL PATENT OFFICE) P.O. BOX 506 MERRIFIELD, VA 22116			FEGGINS, KRISTAL J	
			ART UNIT	PAPER NUMBER

2861

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/063,886	<b>Applicant(s)</b> CHIEN ET AL.	
	<b>Examiner</b> K. Feggins	<b>Art Unit</b> 2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-9 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Sung et al. (US 6,509,920 B1).

#### **Sung et al. disclose the following claimed limitations:**

\* regarding claim 1, a method (disclosed by the operation of the apparatus) for generating a watermark/printing of color dyes/ on a photo picture/object, receiver/ using a thermal printer (Abstract, col 2, lines 54-67);

\* the thermal printer comprising a thermal printhead/74/ for heating an ink ribbon/42. and generating an image through the ink ribbon on a photo picture/receiver/ (col 2, lines 54-67);

\* the ink ribbon comprising a plurality of sequentially arranged color frames, each color frame comprising a plurality of dye frames with different color dyes and a dye frame with overcoating (col 2, lines 54-62, col 6, lines 1-8, figs 2 & 6);

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\* the method comprising: using the thermal printhead to heat a color frame with a plurality of different color dyes and to sublimate the color dyes on a photo picture (col 1, line 60-col 2, line 11, col 2, lines 54-62, col 6 1-8, figs 2 & 6)

\* using the thermal printhead to heat the dye frame with the overcoating and to heat a different area on the dye frame by two distinct time periods (col 1, line 60-col 2, line 11, col 2, lines 54-62, col 6, lines 1-8, figs 2 & 6) /each color frame and the overcoating frame of the ink ribbon is recorded upon at different/distinct/ time periods. The color and the overcoating frames are moved at different/distinct/ times for printing./.

\* regarding claim 2 ; wherein each color frame storing yellow, magenta, and cyan dye; the recited structure limitations does not manipulate the method steps recited in claim 1. Therefore they do not further define the method of claim 1.

\* regarding claim 3; wherein the thermal printer further comprises a winding mechanism for driving the ink ribbon to generate a shift between the thermal printhead and the ink ribbon; the recited structure limitations does not manipulate the method steps recited in claim 1; therefore they do not further define the method of claim 1.

\* regarding claim 4; wherein the thermal printhead is capable of heating different areas on each dye frame stored with different color dyes by a plurality of different time periods, so as to print an image on a photo picture; the recited structure limitations does

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not manipulate the method steps recited in claim 1; therefore they do not further define the method of claim 1.

\* regarding claim 5; wherein the thermal printhead is capable of heating different areas on a dye frame stored with overcoating by two distinct time periods, so as to print an image-shaped overcoating on a photo picture; the recited structure limitations does not manipulate the method steps recited in claim 1; therefore they do not further define the method of claim 1.

\* regarding claim 6; wherein the thermal printer further comprises a controller for adjusting a heating time period for the thermal printhead to heat different areas on each color frame; the recited structure limitations does not manipulate the method steps recited in claim 1; therefore they do not further define the method of claim 1.

***Allowable Subject Matter***

3. Claims 7-9 are allowed.

The following is an examiner's statement of reasons for allowance: The primary reason for allowance of claims 7-9 is the inclusion of a method steps for a thermal printer that includes using a thermal printhead to heat at least two different areas of the overcoating dye frame by at least two distinct time periods to dispose overcoating in at least two distinct thicknesses corresponding to the two distinct time periods to form a watermark image over the sublimated colored dye of the photo picture. It is these steps found in the claim, as it is claimed in the combination of that has not been found, taught

or suggested by the prior art of record, which makes these claims allowable over the prior art.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Katsuda et al. (US 6,130,698) disclose a heat transfer printer that produces an image on a sheet by heating an ink member wherein there is a region for insulating heat produced within the overcoat material transfer region.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Response to Arguments***

4. Applicant's arguments filed Dec 26, 2003 have been fully considered but they are not persuasive. In response to Applicant's argument that heating at different time periods and heating by different time periods are significantly different expressions is acknowledged. However, Applicant has not explicitly claimed the particulars of the two distinct time periods. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to dispute terms. *Constant v. Advanced Micro-devices Inc.*, 7 USPQ2d 1064. Therefore, heating of the yellow portion of the ribbon is considered to be one time period/frame and heating of the magenta portion of the ribbon is considered to be another time period/frame, thereby having a ribbon that is heat at two distinct time

periods (heating of the cyan portion and heating of the overcoating are other time periods of heating the ribbon). Furthermore, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that Sung et al does not disclose "heating of an ink ribbon" is acknowledged. However, the green and the blue light sources are used to position the color frames of the ribbon by different times, prior to heating of the color frame by way of the thermal print head (col 1 line 60-col 2, line 11).

### ***Conclusion***

5. This is a Continuation of applicant's earlier Application No. 10/063886. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


### Communication With The USPTO

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. Feggins whose telephone number is 571-272-2254. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on 571-272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

K Feggins  
K. Feggins  
March 24, 2004

  
LAMSON MCGUEEN  
PRIMARY EXAMINER  
03/30/04